

Remarks

The first paragraph of the specification and the Application Data Sheet have been amended to correct an obvious typographical error with respect to the filing date of priority application 60/009,861, which was filed on January 5, 1996, not January 6, 1996 as originally indicated. The filing receipt indicates the correct date of January 5, 1996 as the filing date of priority application 60/009,861, based on records of the Patent and Trademark Office. The amendments do not introduce any new matter.

Claims 1-96 are currently pending in the application. The restriction requirement (Paper No. 5) separates the claims into two different groups. Group I is defined as claims 1-11, 13-23, 25-35, 37-47, 49-59, 61-71, 73-83, and 85-95, drawn to polynucleotides, vectors, methods of making vectors, host cells, and methods of making polypeptides. Group II is defined as claims 12, 24, 36, 48, 60, 72, 84, and 96, drawn to polypeptides. *See*, Paper No. 5, page 2.

Applicants respectfully traverse the present restriction requirement. Even assuming, *arguendo*, that Groups I and II represented distinct or independent inventions, Applicants submit that to search and examine the subject matter of all the Groups together would not be a serious burden on the Examiner. Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". *See* M.P.E.P. § 803. In the present situation, no such showing has been made. Although the Examiner has argued that Groups I and II are separately classified, Applicants nonetheless submit that a search of the claims of Group I would also provide useful information for the claims of Group II. For example, in many if not most publications disclosing a polynucleotide, the authors also routinely include polypeptides encoded thereby and methods for making the same. Since these searches commonly overlap, Applicants respectfully assert that the concurrent search and examination of Groups I and II would not entail a serious burden.

Accordingly, in view of M.P.E.P. § 803, the claims of Groups I and II should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that the instant claims be examined in one application. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

To comply with the pending election requirement, Applicants herein provisionally elect, *with traverse*, the claims currently restricted to Group I (*i.e.*, claims 1-11, 13-23, 25-35, 37-47, 49-59, 61-71, 73-83, and 85-95). Moreover, since the claims of Group II are drawn to polypeptides made by methods claimed in Group I, Groups II and I are related as between a product and a process for making the product. Furthermore, the product claims of Group II include all the limitations of the process claims of Group I; therefore, the Examiner in any case would be obligated to rejoin the claims of Group II if the process claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Accordingly, Applicants respectfully request that once the method claims of Group I are allowable, the claims of Group II be rejoined.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

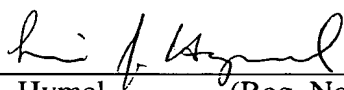
Conclusion

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Lin J. Hymel (Reg. No. 45,414)
Attorney for Applicants

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
(301) 251-6015 (phone)

KKH/MJH/LJH/rmr